

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN ROAD CONSTRUCTION
MACHINES AND COMPONENTS
THEREOF**

**Inv. No. 337-TA-1088
(Rescission)**

COMMISSION ORDER

The Commission instituted this investigation on November 29, 2017, based on a complaint, as supplemented, filed by Caterpillar Inc. of Peoria, Illinois and Caterpillar Paving Products, Inc. of Minneapolis, Minnesota (collectively, “Caterpillar”). *See* 82 Fed. Reg. 56625-26 (Nov. 29, 2017). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337) (“section 337”), based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain road construction machines and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 7,140,693 (“the ’693 patent”); 9,045,871; and 7,641,419. *See id.* The notice of investigation identifies the following respondents: Wirtgen GmbH of Windhagen, Germany; Joseph Vögele AG of Ludwigshafen, Germany; Wirtgen Group Holding GmbH of Windhagen, Germany; and Wirtgen America, Inc. of Antioch, Tennessee (collectively, “Wirtgen”). *See id.* The Office of Unfair Import Investigations is not a party to this investigation. *See id.*

On June 27, 2019, the Commission found a violation of section 337 in the above-identified investigation based on the infringement of claim 19 of the ’693 patent, and issued a limited exclusion order against the infringing articles and a cease and desist order against Wirtgen America (collectively, “the remedial orders”). The United States Customs and Border

Protection (“Customs”) subsequently excluded six Wirtgen redesigned series 1810 machines in December 2019. Based on such exclusion, the Commission issued a seizure and forfeiture order (“SFO”) on January 14, 2020 (corrected January 23, 2020) against Wirtgen America. On March 13, 2020, Wirtgen filed an appeal from the SFO (“the SFO appeal”) to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”).

On January 30, 2020, Wirtgen filed a civil action against Customs and related U.S. government parties (collectively, “the U.S. government”) in the U.S. Court of International Trade (“CIT”) under 28 U.S.C. 1581(a) and (i). The Commission moved to intervene to contest the CIT’s exercise of jurisdiction, and the CIT denied the Commission’s motion. The CIT exercised jurisdiction under section 1581(a) over the U.S. government’s objections and granted summary judgment for Wirtgen as to the excluded entries of the redesigned machines at issue. The CIT also ordered Customs to release the machines for entry into the United States no later than Thursday, May 21, 2020. On July 14, 2020, the U.S. government appealed the CIT’s decision to the Federal Circuit (“the CIT appeal”).

On May 21, 2020, arguing that the predicate for the SFO had been invalidated by the CIT, Wirtgen filed an emergency motion to stay or to temporarily rescind the SFO pending appeal of the CIT’s decision. On June 10, 2020, the Commission determined to deny Wirtgen’s motion to stay, but granted Wirtgen’s motion for temporary rescission of the SFO, thus temporarily suspending the SFO until such time as the CIT’s decision is modified, stayed, or overturned. On June 15, 2020, the Commission filed a motion to stay the SFO appeal pending reinstatement of the SFO by the Commission or resolution of any CIT appeal by the Federal Circuit. On July 29, 2020, the Federal Circuit granted the Commission’s motion to stay the SFO appeal until the suspension of the SFO is lifted or until final disposition of the CIT appeal.

Concurrently, on January 16, 2020, the Commission instituted a modification proceeding to determine whether Wirtgen's redesigned series 1810 machines infringe claim 19 of the '693 patent. On August 31, 2020, the Commission determined that Wirtgen's redesigned machines do not infringe and issued modified remedial orders exempting the redesigned machines from the scope of the orders. Caterpillar did not appeal the Commission's non-infringement determination to the Federal Circuit, and therefore, the Commission's non-infringement determination is now final. Consequently, on November 5, 2020, the U.S. government moved to dismiss the CIT appeal. On December 4, 2020, the Federal Circuit dismissed the CIT appeal.

In view of the Federal Circuit's dismissal of the CIT appeal, it is hereby ORDERED that:

- (1) The SFO is permanently RESCINDED;
- (2) The Secretary shall serve a copy of this Order on the Secretary of the Treasury and all parties of record and shall publish notice thereof in the Federal Register.

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: December 7, 2020

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION ORDER** has been served to the following parties as indicated, on **December 7, 2020**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

**On Behalf of Requester Wirtgen Gmbh, Joseph Vogele AG,
Wirtgen Group Holding GmbH, and Wirtgen America, Inc.:**

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**On Behalf of Respondents Caterpillar Inc. and Caterpillar
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